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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/553,137	02/25/2008	Neil Berinstein	API-03-03-PCT-US	1779
65626	7590	08/07/2008	EXAMINER	
PATRICK J. HALLORAN, PH.D., J.D				NGUYEN, QUANG
3141 MUIRFIELD ROAD		ART UNIT		PAPER NUMBER
CENTER VALLEY, PA 18034				1633
		MAIL DATE		DELIVERY MODE
		08/07/2008		PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)
	10/553,137	BERINSTEIN ET AL.
	Examiner	Art Unit
	QUANG NGUYEN, Ph.D.	1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-10, 36, 37 and 63-66 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) ____ is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) 1-10, 36-37, 63-66 are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ . | 6) <input type="checkbox"/> Other: ____ . |

DETAILED ACTION

Claims 1-10, 36-37 and 63-66 are pending in the present application, and they are subjected to the following restriction.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-10 and 64-66, drawn to an expression vector comprising the nucleic acid sequence as illustrated in SEQ ID NO:5 or a fragment thereof.

Group II, claims 36-37, drawn to an isolated peptide derived from BFA5 as shown in Table X or XI; and a method for immunizing a host against the tumor antigen BFA5 using the same peptide.

Group III, claim 63, drawn to an antibody having the ability to bind the amino acid sequence of SEQ ID NO:6 or a fragment thereof.

The technical feature linking Groups I-III appears to be that they all relate to BFA5 or a fragment thereof.

However at the effective filing date of the present application (4/15/03), at least Jager et al. (WO 01/47959; Cited by the instant application) already cloned the nucleotide sequence BFA5 that was designated NYBR-1 with SEQ ID NO:23 (see at least examples 11-16).

Therefore, the technical feature linking the inventions of Groups I-III does not constitute a special technical feature as defined by PCT Rule 13.2, as it does not differentiate the claimed subject matter as a whole over the prior art. Since according to Rule 13.2 PCT the presence of such a common or corresponding special technical feature is an absolute prerequisite for unity to be established, and given that there does not appear to be any other technical feature common to the claimed subject matter as a whole which might be able to fulfill this role, the currently claimed subject matter lacks unity of invention according to Rule 13.1 PCT.

Consequently, the claimed subject matter is restricted into the above Groups of Inventions for the following reasons.

The currently claimed subject matter (Inventions of Groups I-III) lacks unity of invention according to Rule 13.1 PCT for the following reasons.

The compositions in Groups I-III differ one from the others because they are structurally and chemically different as well as having different properties one from the others. For example, the composition of Group I is made up of nucleotide residues; the composition of Group II is made up of amino acid residues; and the antibody of Group III is composed of a particular amino acid sequence having the ability to bind the amino acid sequence of SEQ ID NO:6 or a fragment thereof.

Because the currently claimed subject matter lacks unity according to Rule 13.1 PCT for the reasons set forth above, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Species restriction

A. Should Applicants elect Group I, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

(a) vaccinia, (b) NYVAC, (c) avipox; (d) canarypox; (e) ALVAC; (f) ALVAC(2); (f) fowlpox; (g) TROVAC; (h) adenovirus; (i) retrovirus; (j) herpesvirus; (k) adeno-associated virus; and (l) plasmid vector.

The claims are deemed to correspond to the species listed above in the following manner:

The claims are directed to an expression vector comprising the nucleic acid sequence as illustrated in SEQ ID NO:5 or a fragment thereof as well as an expression vector comprising a nucleic acid sequence encoding the amino acid sequence of SEQ ID NO:6 or a fragment thereof.

The following claim(s) are generic: at least claims 1 and 64.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each of the above listed vector species is different structurally as well as different properties one from the others. Each different structure can be considered to be a “special technical feature” and therefore the above listed species lack the same or corresponding special technical features.

B. Should Applicants elect Group II, this application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

A single specifically named peptide shown in either Table X or XI (The examiner notes that neither Table X nor Table XI is present in the specification of the as-filed US application).

The claims are deemed to correspond to the species listed above in the following manner:

The claims are directed to an isolated peptide derived from BFA5 as shown in Table X or XI.

The following claim(s) are generic: at least claim 36.

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Each of the isolated peptide in either Table X or XI is different structurally in the primary sequence as well as different properties one from the others. Each different structure can be considered to be a “special technical feature” and therefore the above listed species lack the same or corresponding special technical features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang Nguyen, Ph.D., whose telephone number is (571) 272-0776.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Joseph T. Woitach, Ph.D., may be reached at (571) 272-0739.

To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1633; Central Fax No. (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

/QUANG NGUYEN, Ph.D./
Primary Examiner, Art Unit 1633

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